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08/914,789 08/20/97 KATZ

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EXAMINER

LM01/1127

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MARCH, P
ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/914,789

Applicant(s)

Katz et al.

Examiner

Philip Marsh

Group Art Unit

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☒ Responsive to communication(s) filed on Aug 20, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
2. The disclosure is objected to because of irregularities as noted on PTO 948. Appropriate correction is required.

Claim Objections

3. Claims 1-3, 16 and 22 are objected to because of the following informalities:
4. As per claim 1, the subparagraph indicator “d)” is used twice in the claim. Therefore, the second “d)” should be changed to “e)” and the last step should be labeled “f)”.
5. As per claim 2, because of the change in the subparagraph indicators in claim 1, the further step in claim 2 should be changed from “f)” to “g)” and the step “e)” should be changed to “f)”.
6. As per claim 3, “step f)” in line 1 should be changed to “step g)”.
7. As per claim 16, the subparagraph indicator “d)” is used twice in the claim. Therefore, the second “d)” should be changed to “e)” and the last step should be labeled “f)”.
8. As per claim 22, the steps “a)”, “b)”, and “c)” should be changed to “g)”, “h)”, and “i)” respectively to correspond with the lettering in claim 16.

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Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-10 and 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. As per claims 1 and 16, the last item includes "... preparing reports from said integrated data and said previously stored data...". It is unclear what is meant by this since the said previously stored data is included within the integrated data from the previous item within the claim ("... automatically integrating said data with previously stored data..."). For the purposes of examination, it will be assumed that the words "and said previously stored data" are to be left out in both of these claims.

12. Claim 3 recites the limitation "electronically transmitting" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, it will be assumed what is meant by this is simply "transmitting".

13. Claims 2-10 and 17-22 are rejected for depending from a rejected independent claim.

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Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoffel et al. (US Patent 5,274,547) in view of Prince (Prince, Cheryl J.; "Compliance Vendors do Battle in Newly Competitive Market", Bank Systems and Technology, v32 n2 pp. 22-24, Feb. 1995) and in further view of CFI ("CFI Proservices Announces a New Software Product that Simplifies Fair Lending", PR Newswire; June 1, 1994).

16. As per claims 1-2, 5, and 10, Zoffel teaches a method for storing and compiling data for analysis and reporting comprising the steps of:

a) automatically extracting financial regulatory data from a plurality of sources ("The central data processor requests credit information ... from one or more of he repositories, generates a ... report, and transmits the report.", abstract);

b) automatically reformatting said data so that said data is formatted (column 18, lines 48-61);

d) automatically storing the data in a repository ("... the software maintains an orderly filing system for the merged reports returned from central data processor 22.", column 6, lines 14-15);

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e) automatically integrating said data with previously stored data (“... the central data processing facility eliminates duplicated data, selects the best data if there are conflicts, and merges the remaining data into a single report.”, abstract);

f) preparing reports from said integrated data on a periodic basis (“... the central data processing facility ... merges the remaining data into a single report”, abstract); and

g) transmitting said reports prepared in step f) (“The final report is returned electronically to a computer terminal designated by the subscriber ...”, column 3, lines 31-32).

Zoffel does not teach that the data and reporting regard a financial institution’s compliance with fair lending laws, or that data is automatically normalized.

The examiner takes official notice that normalization of data is old and well-known in the art of financial institution reporting. CFI teaches “... reporting and analysis” and Prince teaches “using sophisticated statistical analysis”. These two analyses, while not stating it explicitly, would likely incorporate normalization techniques, which would have been obvious to one of ordinary skill in the art at the time of invention because normalization is among the most rudimentary forms of statistical data analysis.

CFI teaches a method of automatically generating reports in electronic formats regarding the fair lending laws. It would have been obvious to one of ordinary skill in the art at the time of the application to combine the method of Zoffel with the application of the automatic generation of reports in electronic formats regarding the fair lending laws as taught by CFI because both references teach reporting financial regulatory information and would be applied just as easily to

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one type of information, like fair lending laws information, as another, such as credit report information with similar benefits.

17. As per claims 3 and 4, Zoffel in view of CFI and further in view of Prince as applied in paragraph 16 of this office action teach all of the limitations of these claims except that the reports are to be transmitted on a predetermined date to regulators, including the OCC, FRS, FDIC, and OTS. Both Prince and CFI teach the method of reporting to regulators of financial institutions, but do not specify the regulators indicated in claim 4, nor that this is to be done on a predetermined date. The examiner takes official notice that the practice of reporting to the OCC, FRS, FDIC, and OTS on a predetermined date is well-known in the art of regulatory reporting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine reporting regulatory, financial data with the practice of reporting to the OCC, FRS, FDIC, and OTS on a predetermined date in order to maintain good standing with these regulators.

18. As per claims 6 and 7, Zoffel in view of CFI and further in view of Prince as applied in paragraph 16 of this office action teach all of the limitations of these claims except that the step of extracting is performed on a regular, monthly basis. The examiner takes official notice that the practice of extracting regulatory financial data on a monthly basis is old and well-known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine reporting regulatory, financial data with the practice of extracting data on a

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regular, monthly basis because most of the existing financial software is programmed to work in month-long intervals, and this would allow better compatibility with existing software.

19. As per claims 8 and 9, Zoffel in view of CFI and further in view of Prince as applied in paragraph 16 of this office action teach all of the limitations of these claims except that the plurality of sources in claim 1 may be branches of a financial institution, and bankcard processing centers, student loan processing centers, business loan processing centers, and US territorial locations of the financial institution. The examiner takes official notice that the practice of extracting data from a plurality of sources including those listed in claims 8 and 9 is well-known. Such data extraction occurs daily at Automatic Teller Machines (ATMs) on a daily basis. It would have been obvious to combine the extraction of data from the sources listed in claims 8 and 9 because the information regarding the financial institution's compliance with fair lending laws must be compiled from information throughout the financial institution, making such communication would be necessary.

20. As per claims 11, and 14-15, Zoffel teaches an apparatus for performing data collection and analysis, comprising:

a) a plurality of feeds, one for each business unit within the financial institution ("The central data processing facility or host computer 22 is also linked to repositories of credit information. These, identified by reference characters 30, 32, and 34 in Fig. 1, will typically be the national credit repositories: TRW, CBI, and Trans Union. Any number of subscribers can access central data processing facility 22 and request credit reports. The data communications

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links between the additional subscriber terminals and central facility 22 have not been shown as they may duplicate the one that is illustrated ...”, column 4, lines 56-66; “The central data processor requests credit information ... from one or more of he repositories, generates a ... report, and transmits the report.”, abstract);

b) standardizing means for standardizing said data received from said feeds (column 18, lines 48-61);

c) a repository, which may be a server on a network, for receiving said standardized data and for storing the standardized data (“... the software maintains an orderly filing system for the merged reports returned from central data processor 22.”, column 6, lines 14-15); and

d) a workstation, which may be a personal computer (“Personal Computer”, Fig. 1, 26), for outputting compliance reports and analysis using said data wherein workstation reports regulatory financial data (“The central data processor requests credit information ... from one or more of he repositories, generates a ... report, and transmits the report.”, abstract; “The final report is returned electronically to a computer terminal designated by the subscriber ... for the credit report.”, column 3, lines 31-33).

Zoffel does not teach that the data and reporting regard a financial institution’s compliance with fair lending laws, or that data is automatically normalized.

The examiner takes official notice that normalization of data is old and well-known in the art of financial institution reporting. CFI teaches “... reporting and analysis” and Prince teaches “using sophisticated statistical analysis”. These two analyses, while not stating it explicitly,

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would likely incorporate normalization techniques, which would have been obvious to one of ordinary skill in the art at the time of invention because normalization is among the most rudimentary forms of statistical data analysis.

CFI teaches a method of automatically generating reports in electronic formats regarding the fair lending laws. It would have been obvious to one of ordinary skill in the art at the time of the application to combine the method of Zoffel with the application of the automatic generation of reports in electronic formats regarding the fair lending laws as taught by CFI because both references teach reporting financial regulatory information and would be applied just as easily to one type of information, like fair lending laws information, as another, such as credit report information with similar benefits.

21. As per claims 12 and 13, Zoffel in view of CFI and further in view of Prince as applied in paragraph 20 of this office action teach all of the limitations of these claims except that the repository comprises a mainframe computer or server on a network. The examiner takes official notice that the use of mainframe computers and servers on networks as repositories would have been well-known in the art at the time of the invention and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a mainframe computer or a server on a network at the repository for the apparatus taught in claim 11 because it would have increased storage capacity (in the case of the mainframe) and accessibility of the information (in the case of the server).

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22. As per claim 16-17, 19-21 Zoffel teaches a device for enabling a financial institution to comply with regulatory laws, comprising:

a) extracting means for automatically extracting regulatory financial data from a plurality of sources (“The central data processor requests credit information ... from one or more of the repositories, generates a ... report, and transmits the report.”, abstract);

b) reformatting means for automatically reformatting said data so that said data is in a standard format (column 18, lines 48-61);

d) storing means for automatically storing the data in a repository (“... the software maintains an orderly filing system for the merged reports returned from central data processor 22.”, column 6, lines 14-15);

e) integrating means for automatically integrating said data with previously stored data (“... the central data processing facility eliminates duplicated data, selects the best data if there are conflicts, and merges the remaining data into a single report.”, abstract); and

f) preparing means for preparing reports from said integrated data on a periodic basis, and transmitting means for transmitting the reports (“... the central data processing facility ... merges the remaining data into a single report”, abstract).

Zoffel does not teach that the transmitted reports are for regulators of the financial institution, a geo-coding means for geo-coding data, that reports include indication of CRA and HMDA compliance and determination of trend analysis for the data, that the data and reporting

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regard a financial institution's compliance with fair lending laws, that data is automatically normalized, .

The examiner takes official notice that normalization of data is old and well-known in the art of financial institution reporting. CFI teaches "... reporting and analysis" and Prince teaches "using sophisticated statistical analysis". These two analyses, while not stating it explicitly, would likely incorporate normalization techniques, which would have been obvious to one of ordinary skill in the art at the time of invention because normalization is among the most rudimentary forms of statistical data analysis.

CFI teaches a method of automatically generating reports in electronic formats regarding the fair lending laws. It would have been obvious to one of ordinary skill in the art at the time of the application to combine the method of Zoffel with the application of the automatic generation of reports in electronic formats regarding the fair lending laws as taught by CFI because both references teach reporting financial regulatory information and would be applied just as easily to one type of information, like fair lending laws information, as another, such as credit report information with similar benefits.

Prince teaches reports including indication of CRA and HMDA compliance for a financial institution ("... blends HMDA reporting with Community Reinvestment Act reporting features as well", page 1, lines 9-10; "... combining HMDA and CRA reporting and analysis.", page 1, line 36). It would have been obvious to one of ordinary skill at the time of invention to combine the CRA and HMDA compliance reporting as taught by Prince with the device taught

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by Zoffel because both references teach reporting financial regulatory information in different fields. In the field taught by Prince, the CRA and HMDA are the people who need to receive the reports which are produced by the software, and are, therefore, the natural receivers of these reports.

Prince teaches “data geocoding by geographic location” (page 2, line 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the device taught by Zoffel with the geo-coding as taught by Prince because the geo-coding is a technique germane to CRA and HMDA compliance assessments and would necessarily be included in any reports indicating CRA and HMDA compliance assessments.

CFI teaches that “... Pro Active can help lenders detect and eliminate unfair lending patterns and practices ...”, thereby determining trend analysis for the report data. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the trend determining ability of CFI with the device taught by Zoffel because fair lending law data reporting is used to determine unfair practices and trends by regulatory agencies. To prevent legal action the institution performing the CRA and HMDA compliance assessment would need to determine trend analysis before submitting a report of compliance assessment data.

CFI teaches that “Pro Active will generate HMDA report in the electronic formats required by federal agencies ...” (page 1, lines 45-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the automatic, electronic reporting

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of Zoffel with the electronic reports required by the regulatory federal agencies as taught in CFI because this is the group of people who have the most interest in the contents of such a report.

23. As per claim 18, Zoffel in view of CFI and further in view of Prince as applied in paragraph 22 of this office action teach all of the limitations of these claims except that the regulators to which the report is transmitted includes the OCC, FRS, FDIC, or OTS. The examiner takes official notice that the practice of reporting to the OCC, FRS, FDIC, and OTS is well-known in the art of regulatory reporting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine reporting regulatory, financial data, as taught by Zoffel, with the practice of reporting to the OCC, FRS, FDIC, and OTS because these agencies are concerned with monitoring such data in the private, financial sector.

24. As per claim 22, Zoffel in view of CFI and further in view of Prince as applied in paragraph 22 of this office action teach all of the limitations of these claims except:

- g) backing up means for backing up said data stored in said storing means;
- h) archiving means for archiving said data stored in said storing means; and
- i) purging means for purging data stored in said storing means.

The examiner takes official notice that backing up, archiving and purging would all have been well-known in the art at the time of the invention. It would have been obvious, therefore, to combine the device as taught by Zoffel with these practices to prevent data loss, promote long-term financial record integrity, and prevent memory from filling up completely.

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Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marshall, William T.; "Examinations at a Distance. (Off-Site Bank Evaluations)", America's Community Banker, v6, n7, p16(6), July, 1997.

Gamble, Richard H.; "Compliance Help", Independent Banker, v47, n7, p67-68, July 1997.

"New Software Brings HMDA Data to Desktop", Regulatory Compliance Watch, v4, n48, p4, December 19, 1994.

Henry, Shannon; "CRA Software Wins Raves for Speed, Flexibility. (PCI Services CRA Wiz Community Reinvestment Act Compliance Software)", American Banker, v160, n119, p8, July 22, 1995.

Schulz, Matt; "Cheaper Access on Internet Seen Forcing Innovation by Compliance Vendors", American Banker, v161, n123, p12, June 27, 1996.

Schulz, Matt; "N.Y. Banking Department Acts to Standardize CRA Regulations, Examinations", American Banker, v161, n89, p8, May 9, 1996.

"Fair Lending: New CRA Rules Will Transfer Most of Compliance Burden to Regulators", BNA Banking Daily, April 28, 1995.

"CRA Specialist", Credit Risk Management Report, v5, n6, March 13, 1995.

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"CFT ProServices Exec Follows Impact of Regulations on Bank", Business Journal-Portland, v10, n49, p13, January 28, 1994.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Marsh whose telephone number is (703) 305-0434. The examiner can normally be reached Monday-Thursday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.


The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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November 18, 1998


ROBERT A. WEINHARDT
PRIMARY EXAMINER